

REMARKS

The present application now contains claims 29-45 and 66-76 and 80-91. Claims 85-91 have been added.

Claims 29, 80, 83 and 84 (all of the previously presented independent claims) have been amended by changing "base layer" to "at least one base layer". This change, which is in line with the disclosure of multiple layers beneath the release layer, was made to provide a logical basis for claims 85-88. This amendment does not limit the scope of the claim and may be considered a broadening amendment. Claims 85-88 are added to further define the invention as originally disclosed.

Claims 89-91 correspond to previously cancelled claims 77-79. Claims 77-79 were removed based on alleged non-unity of invention. However, if the independent claims are allowed, the alleged non-unity will be moot, and the claims are allowable.

Claims 29-45, 66-76 and 80-84 stand rejected under 35 U.S.C. §112, first paragraph, as not being enabled. The Examiner indicates that applicant has support for non-tackiness only for a limited thickness and limited low values of silicone oil and filler material. The claims differ in their scope in this regard.

For example, claim 29 does no more than recite the materials in the original claim 29 with the added limitation of non-tackiness. Since claim 80 does not mention tackiness at all, it is not clear how the rejection under 35 U.S.C. § 112 applies to this claim at all. Claim 83 contains the limitation that the member has "a *non-tacky* outer release layer consisting *essentially* of a condensation cured silicone." The conjunction of *non-tacky* and *essentially* means that *essentially* refers to non-tacky and that there are no materials in the layer that would cause it to be tacky. Claim 84 claims "an outer release layer consisting essentially of a condensation cured silicone without additives that would cause it to become tacky", which is an even more explicit teaching. Yet all of these claims are rejected on this basis.

In previous office actions, the Examiner indicated that the prior art Japanese reference cited taught all of the limitations of claim 29 (which did not have the non-tacky limitation.) Applicants added the term "non-tacky" to the claims to differentiate over the prior art in which the intermediate member was tacky. Applicants submitted evidence that the non-tacky nature of the intermediate transfer member was implicitly taught by the teaching that the intermediate transfer member could be used for liquid toner. This should have been enough (and in applicants' opinion was enough) to support the additional term. The Examiner then demanded proof that the examples

UDD

would actually result in a non-tacky intermediate transfer member. Experiments were run using a range of different silicone oil additives at different concentrations to show that the examples were, in fact, non-tacky.

The thickness, low percentage of filler material and silicone oil are listed in the patent as preferred embodiments and are not defined as limiting the disclosed use with liquid toner to just these values. *Two of these parameters actually have nothing to do with tackiness, namely, the thickness and filler material percentage.*

Applicants "showing" of non-tackiness is basically from the patent itself and is based on the teaching that the members can be used with liquid toner. The claims define the member essentially as originally claimed, with the additional limitation, made explicit in the claims, that the member is not tacky. All that is necessary to support this claim is a showing that non-tackiness is taught by the application and that it is inherent in at least some of the examples. *The possibility that some examples or that some members produced under some circumstances would be tacky is really irrelevant, since the claim itself is self limiting and excludes tacky members.*

A relevant case is *In re Cook*, 169 USPQ 298, 302 (C.C.P.A. 1971) (quoting *In re Skrivan*, 166 USPQ 85, 88 (C.C.P.A. 1970)), which states:

"[M]any patented claims read on vast numbers of inoperative embodiments in the trivial sense that they can and do omit "factors which must be presumed to be within the level of ordinary skill in the art," . . . and therefore read on embodiments in which such factors may be included in such a manner as to make the embodiments inoperative. There is nothing wrong with this so long as it would be obvious to one of ordinary skill in the relevant art how to include those factors in such a manner as to make the embodiment operative rather than inoperative. . . . The word "obvious" as here used means that those skilled in the art would know how to determine utility without having to build and try out the conceived embodiment and could do so without the expenditure of unreasonable effort."

A person of ordinary skill in the art would know that adding large amounts of oil or any tackifier would render a silicone tacky. The exact amount would depend on the actual silicone material and the amount of oil. The claims exclude those embodiments and the preferred variations in the disclosure delineate safe amounts for particular mix of silicones. This does not mean that the claims must specifically include these limitations.

Applicants repeat that the amounts of fillers or thickness is believed to be irrelevant to the question of tackiness. (Consider, for example that commercial silicone precursors can have up to 25% fillers and are not tacky.). Furthermore, applicants repeat that the rejection appears to be irrelevant to claim 80 and clearly overcome by the wording of claims 83 and 84.

Claims 29, 35-41, 76 and 80-84 stand rejected under 35 U.S.C. §102(b) as being

UDD

anticipated by applicants' statement of the prior art. Although the Examiner has not cited any particular part of the disclosure, applicants believe that he is referring to page 2, lines 10-19. Applicants respectfully traverse the rejection and submit that it does not provide a *prima facie* case of anticipation.

Applicants note that the Examiner does not reject the claims based on the art itself. Rather, the Examiner appears to be rejecting the claims based on what the applicants say about the art. However, the relevant description of the art in the application is sufficiently distinguishable from the reference to avoid anticipation.

Firstly, as to all the rejected claims, the reference is to a fuser and not to an intermediate transfer member, as claimed. Claim 29 claims that "the transfer member is capable of receiving toner images from a first surface and transferring said toner images to a second surface." The function of the fuser of the reference, is in fact the opposite, it is *designed* not to receive an image, but rather to leave it on the item to which it is to be fused. Claims 80 and 83 contain similar wording. While claim 84 does not contain this wording, it is to an image transfer member, which is not what the cited reference refers to.

Secondly, claim 80 defines a maximum amount of filler. The amount of filler in the prior art reference is not specified in present application, except to state that various amounts are specified. Thus the prior art as described in the application does not appear to be a proper basis for rejection as anticipating.

If the Examiner has any questions and/or suggestions with respect to the application, the undersigned can be reached at toll free number 1 (877) 428-5486. Kindly note that this is a direct line to the undersigned's office in Israel which is 7 hours ahead of Washington. Usually, the undersigned can be reached at this number before 11:00 AM Washington time. Alternatively, the undersigned can be reached by e-mail at fensterco@attglobal.com.

In view of the above amendments and remarks, applicants submit that the application is ready for allowance. Notice to this effect is respectfully awaited.

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Respectfully submitted,
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